

## **REMARKS**

In the Office Action, the Examiner rejected claims 1-18. The Applicant requests reconsideration of claims 1-18 in view of the following remarks. In the present Response, the Applicant is amending claims 1-16 to address the Examiner's concerns. No new claims are presently added. Thus, claims 1-18 are pending in the Application.

Claims 1-18 were rejected under 35 U.S.C. §101 because they disclose a claimed invention that is an abstract idea as defined in the case *In re Warmerdam*, 33 F.3d 1354, 31 U.S.P.Q.2d 1754 (Fed. Cir. 1994). Additionally, the Examiner rejected claims 1-18 under 35 U.S.C. § 102(e) as anticipated by Notani et al. (U.S. Patent No. 6,442,528), hereafter referred to as “the Notani reference.”

### **Claim Rejections under 35 U.S.C. § 101**

As set forth above, the Examiner rejected claims 1-18 under 35 U.S.C. §101 because they disclose a claimed invention that is an abstract idea as defined in the case *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed.Cir. 1994). The Applicant respectfully traverses this rejection.

The Applicant respectfully asserts that the present claims are directed to statutory subject matter. Any analysis of whether a claim is directed to statutory subject matter begins with the language of 35 U.S.C. § 101, which reads:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In interpreting Section 101, the Supreme Court stated that Congress intended statutory subject matter to “include *anything* under the sun that is made by man.” *Diamond v.*

*Chakrabarty*, 447 U.S. 303, 309, 206 U.S.P.Q. 193, 197 (1980) (emphasis added). Although this statement may appear limitless, the Supreme Court has identified three categories of unpatentable subject matter: laws of nature, natural phenomena, and abstract ideas. *See*, *Diamond v. Diehr*, 450 U.S. 175, 182, 209 U.S.P.Q. 1, 7 (1981). Accordingly, so long as a claim is not directed to one of the three specific areas listed above, the claim is directed to patentable subject matter. Thus, it is improper to read into Section 101 regarding subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitation. *In re Alappat*, 31 U.S.P.Q.2d 1545, 1556 (Fed. Cir. 1994) (citing *Chakrabarty* 447 U.S. at 308).

For example, the fact that a claim includes or is directed to an algorithm is no ground for holding a claim is directed to non-statutory subject matter. *See, In re Iwashashi*, 12 U.S.P.Q.2d 1908, 1911 (Fed. Cir 1989). Rather, the proscription against patenting an algorithm, to the extent it still exists, is narrowly limited to *mathematical algorithms in the abstract*, e.g., describing a mathematical algorithm as a procedure for solving a given type of mathematical problem. *See, AT&T Corp. v. Excel Communications, Inc.*, 50 U.S.P.Q.2d 1447, 1450 (Fed. Cir 1999). Indeed, the courts are aware that any step-by-step process, be it electronic, chemical, or mechanical, involves an algorithm. *Id.* at 1450.

Thus, inquiry into what is statutory subject matter simply requires “an examination of the contested claims to see if the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a ‘law of nature’ or an ‘abstract idea, or if the mathematical concept has been reduced to some practical application rendering it ‘useful.’” *Id.* at 1451 (citing and quoting *In re Alappat*, 31 U.S.P.Q.2d at 1557). Furthermore, a Section 101 analysis “demands that the focus in any statutory subject matter

analysis be on the *claim as a whole*.” *In re Alappat*, 31 U.S.P.Q.2d at 1557 (citing *Diehr*, 450 U.S. at 192) (emphasis in original). Indeed, the dispositive inquiry is whether the claim *as a whole* is directed to statutory subject matter, it is irrelevant that a claim may contain, as part of the whole, subject matter that would not be patentable by itself. *Id.*

The Applicant respectfully disagrees with the Examiner’s assertions and interpretation of the law. Indeed, the Applicant asserts that the Examiner’s concerns regarding the provision of “substance” upon which the claimed invention acts are unsupported. As set forth in *Ex Parte Lundgren*, “[a] series of steps which meets the definition of a statutory ‘process’ is *not* an ‘abstract idea’ because of the concrete, physical acts.” *Ex Parte Lundgren*, page 43 (emphasis added). Furthermore, “a ‘process’ is not required to recite the means (structure) to perform the steps.” *Id.* Additionally, if the Examiner is attempting to apply a “technological arts” test, it is made clear in *Ex Parte Lundgren* that such a test does not exist. *Ex Parte Lundgren*, pages 6-7. The methods recited by claims 1-16, which include concrete acts, are clearly useful for enabling automatic, template-driven generation of processes and services that can interact according to B2B interaction standards. *See Application*, page 8, line 1 – page 9, line 4.

Regarding claims 17 and 18, the Applicant asserts that the Examiner’s concerns are completely inappropriate. Structure is recited throughout these system claims. For example, major components of independent claim 17 include “a structured process definition generator,” “a process template generator,” and “a process template repository.” Claim 18, which depends from claim 17, includes “a service template repository.” Clearly, these claims include substance and, like claims 1-16, are clearly useful for enabling automatic, template-driven generation of processes and services that can interact according to B2B interaction

standards. *See Application*, page 8, line 1 – page 9, line 4. Accordingly, the Applicant respectfully submits that the pending claims are directed to statutory subject matter, and respectfully requests reconsideration and allowance of the pending claims.

### **Claim Rejections under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-18 under 35 U.S.C. § 102(e) as anticipated by Notani et al. (U.S. Patent No. 6,442,528), hereinafter referred to as “the Notani reference.” Specifically, with regard to the independent claims the Examiner stated:

Notani et al teaches,  
receiving a description of a business-to-business  
interaction standard (summary of the invention);  
converting the description of business-to-business  
interaction standard to a structured representation of the  
business-to-business interaction standard (column 3, lines 39-  
52);  
automatically generating at least one process template  
based on the structured representation of the business-to-  
business interaction standard (column 15, lines 35-47); and  
using the process template to design a workflow  
(column 17, lines 44-54).

Office Action, pages 3-4.

The Applicant respectfully traverses this rejection. Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984).

Accordingly, the Applicant needs only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

On a preliminary note, the Applicant stresses that the Examiner's rejections are vague regarding the various claim features and, thus, the Applicant reminds the Examiner that:

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 C.F.R. § 1.104(c)2; *see also* M.P.E.P. § 707.07.

Turning to the claims, independent claim 1 recites, *inter alia*, "receiving a description of a business-to-business interaction standard ... converting the description ... to a structured representation of the *business-to-business interaction standard* ... automatically generating at least one *process template* based on the structured representation ... [and] using the process template to design a workflow." (Emphasis added).

The Applicant asserts that the cited reference fails to anticipate the present claims because it fails to disclose each and every feature recited therein. For example, in the Office Action, the Examiner submitted that the "summary of the invention" portion of the Notani reference discloses receiving a description of a *business-to-business interaction standard*. *See* Office Action, page 4. However, the Applicant asserts that the cited portion of the Notani reference fails to even mention a *business-to-business interaction standard*. To emphasize this deficiency, the cited portion of the Notani reference is set forth below:

In accordance with the present invention, an exemplar workflow used for the design and deployment of a workflow for enterprise collaboration is disclosed that provides advantages

over conventional supply chain, enterprise and site planning environments.

According to one aspect of the present invention, an exemplar is disclosed for use in the design and deployment of a workflow for enterprise collaboration. A computer implemented process involves allowing a workflow design to include at least one exemplar workflow. The exemplar workflow is associated with an exemplar node allowing at least one activity to be parameterized over a plurality of nodes within a node group. The process then involves instantiating the workflow such that at least one exemplar workflow is instantiated as a plurality of activities each associated with a specific node in the node group. The workflow is deployed by distributing the activities over the nodes in the node group to provide multi-enterprise collaboration.

A technical advantage of the present invention is the ability to design, instantiate, deploy, execute, monitor and modify sophisticated multi-enterprise collaborations using an exemplar workflow for a group of related nodes.

Additional technical advantages should be readily apparent to one skilled in the art from the following figures, descriptions, and claims.

Notani et al., col. 2, lines 22-48.

Clearly, the Notani reference does not teach the presently recited business-to-business interaction standard. Moreover, the Notani reference certainly does not disclose *converting* the business-to-business interaction standard to a structured representation.

Additionally, the Notani reference fails to disclose “automatically generating at least one process *template* based on the structured representation of the business-to-business interaction standard.” Indeed, there is no disclosure whatsoever of a *process template*. To emphasize this deficiency, the portion of the Notani reference cited by the Examiner as teaching this feature is set forth fully below:

A further important feature is the integration of automated workflows with user-oriented workflows. Workflows can often be described as having two varieties: automated system-to-system workflows, and user interface workflows. While there are workflows that are completely

automated, and there are workflows that are completely user driven, most workflows have automated as well as user interface elements. The present global collaboration manager and designer do not need to make this artificial distinction between workflow types. Hence, the workflows can be automated in parts and interact with users in other parts. Both the automated parts and user parts can span multiple enterprises.

Notani et al., col. 15, lines 35-47.

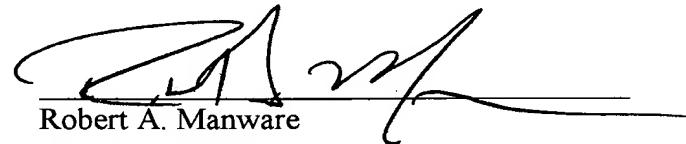
The Examiner did not address the subject matter of independent claims 11 and 17, as set forth above, with any specificity. Indeed, in the Office Action, the Examiner essentially failed to address any distinctions between claims 1, 11, and 17. While the Applicant does not agree with the Examiner addressing these claims together, insomuch as the Examiner's rejection is identical on all of these claims, claims 11 and 17 are believed to be equally patentable for the reasons summarized above with respect to claim 1.

For these reasons, the Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 102 of independent claims 1, 11, and 17, and the claims depending therefrom. Further, the Applicant requests an indication of allowance for claim 1, 11, and 17, and the claims depending therefrom.

**Conclusion**

In view of the remarks set forth above, the Applicant respectfully requests allowance of claims 1-18. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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